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IN THE

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT

JOHN KITCHEN JR. CO.,
(A Corporation)

vs.

ALEXANDER LEVISON,

Appellant,
Appellee.

In Equity,
On Reissue Patent
No. 12005.

PETITION FOR RE-HEARING ON BEHALF
OF APPELLANT.

CHARLES E. TOWNSEND
Solicitor for Complainant

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Your petitioner feeling aggrieved by the decision of this Honorable Court in the above-entitled cause, hereby respectfully requests a re-hearing of said cause and that the decree may be modified at least with respect to the conclusion of infringement for the reasons hereinafter stated.

Counsel for appellant is not unmindful that this Honorable Court is regularly besieged with petitions of this character by disappointed litigants and that such petitions are with rare exceptions, as regularly denied. Hence in bringing this petition it is most earnestly urged that it may be considered as directed not in criticism of any course of reasoning followed by the Court, nor of any collateral matters previously considered, leading up to the Court's final decision, nor as attempting to revamp old arguments, but sim-

ply to call the Court's attention to certain rules of construction not heretofore brought to the Court's attention in this case, nor as far as your humble petitioner knows, in any previous case. It is not our desire nor intention to attempt to reargue the case, but to accept at the outset for the purpose of this motion:

(1) The conclusions of the Court that the Levison patent is not anticipated, but is a valid combination; and

(2) The conclusion of the Court that the appellant's carbon is in effect a "bound" carbon.

The point which we wish to present to your Honors pertains solely to the deduction as to *infringement* or *non-infringement* following the finding that the appellee's patent is valid, and that the appellant's carbon is a "bound" carbon, and is based on the rule of law laid down by the Supreme Court of the United States in *Westinghouse v. Boyden Power Brame Co.* 170 U. S. 537, 42 L. Ed. 1136, and other leading cases that:

"RESPONDENT'S DEVICE MAY BE LITERALLY WITHIN THE CLAIMS OF THE PATENT SUED ON, BUT IT DOES NOT NECESSARILY PROVE INFRINGEMENT."

It would seem that your Honors having decided that appellant's carbon was a "bound" carbon, felt necessarily obliged in view of the *validity* of the Levison patent and the *terms* of the Levison claims, to conclude that the appellant's device was an *infringement*.

It is on this one point alone that error is urged and it is urged not alone on behalf of appellant, but as a duty to this Court and to the public.

I.

ALTHOUGH APPELLANT'S DEVICE IS LITERALLY WITHIN THE TERMS OF THE LEVISON PATENT, THE COURT IS NOT NECESSARILY BOUND TO HOLD THERE IS INFRINGEMENT.

Elec. Signal Co. vs. Hall Signal Co., 114 U. S., 87; 29 L. Ed. 96;

Westinghouse vs. Boyden P. B. Co., 170 U. S. 537; 42 L. Ed. 1136;

Cushman Paper Box Co. vs. Goddard, 95 Fed. 664;

Goodyear Shoe Co. vs. Spalding, 101 Fed. 990;

Edison vs. American Mutoscope & Biograph Co., 151 Fed. 767;

Page Mach. Co. vs. Dow Co., 166 Fed. 473, 476 C. C. A.;

Herzog vs. N. Y. Tel. Co., 172 Fed. 425; Affirmed. 176 Fed. 349;

Columbia Motor Car Co. vs. Duerr Co., 184 Fed. 893; C. C. A. (Selden Automobile Patent).

Infringement is not made out merely by showing that the defendant's device comes within the terms of complainant's patent.

“Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant's device. *Two things are not precisely similar because the same words are applicable to each.* The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative as well as qualitative.” (Goodyear Shoe Mach. Co. v. Spalding (C. C.) 101 Fed. 990). Edison v. American Mutoscope & Biograph Co., 151 F. 767, 773 (2nd Cir., 1907).

IF THE LEVISON PATENT IS NOT A PIONEER BUT REPRESENTS MERELY AN IMPROVEMENT ON THE PRIOR ART, THOUGH A MERITORIOUS ONE, THEN THE FACT THAT APPELLANT'S DEVICE IS LIKEWISE PATENTED BECOMES IMPORTANT IN VIEW OF THE CASES NOW REFERRED TO.

In Electric Signal Co. v. Hall Signal Co., 114 U. S. 87, 29 L. Ed. 96, the Supreme Court laid down the proposition that the defendant's device might be literally within the words of the claims of a patent and yet not infringe. In that case the patent sued on concerned a safety railway signal device in which the claims were for “positive and negative conductors,” *shown as two wires stretched on poles extending along the railway track.* The defendants accomplished the same result by *grounding* one of the conductors, and although the Court held the patent valid and from the opinion it appears that the defendants were liter-

ally within the claims sued on, yet on the question of infringement the Court held for the defendants. In the course of the opinion the Court said:

“The object of the patent combination was the accomplishment of a particular result, that is, to work electric signals on what was known as the ‘block’ system, by means of circuits, operated by a single battery instead of many. But this result or idea is not monopolized by the patent. The thing patented is the particular means devised by the inventor by which that result is attained, *leaving it open to any other inventor to accomplish the same result by other means*. To constitute identity of invention, and therefore infringement, not only must the result attained be the ‘same,’ but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function, provided, however, that the differences alleged are not merely *colorable*, according to the rule forbidding the use of *known equivalents*.”

In view of the Patent Office having granted Kitchen a separate patent on his very *friction binding* means here involved, it cannot be said that the differences are merely “colorable.” Nor can it be said that the “friction binding” means of Kitchen was such a “known equivalent” as to make it a mere obvious substitute for the *stitching* of Levison.

In *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 42 L. Ed. 1136, the general proposition is laid down that:

“A respondent’s device may be literally within the claims of the patent sued on, but it does not necessarily prove infringement.”

In that case the Court said:

“But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse’s claims that does not settle conclusively the question of infringement. * * * *

“The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. ‘An infringement’ says Mr. Justice Grier in *Burr v. Duryee*, 68 U. S., 1 Wall. 531, 572 (17: 650,658), ‘involves substantial identity whether that identity be described by the terms “same principle”’, same “modus operandi”’, or any other * * * The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term “equivalent”’.

“We have no desire to qualify the repeated expression of this Court to the effect that where the invention is functional, and the defendant’s device differs from that of the patentee only in form, or in a rearrangement of the same elements of a combination, he would be adjudged an infringer, even if, in certain particulars, his device be an improvement upon that of the patentee. But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function. Mere variations of form may be disregarded, but the substance of the invention must be there. * * *

“That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other.”

In that case, famous as one of the leading cases in patent law, the defendant operated under a patent, just as the appellant here operates under a subsequent patent, and the Court found that while the patent there in suit was valid and the functions of the two devices practically the same, the means used in ac-

completing this function was so different that they were held not to be mechanical equivalents.

The very fact that *Kitchen* was granted a patent for his *specific binding means* is repugnant to the idea that his *frictional* binding means are the mechanical equivalent of the *stitching binding* of Levison. If so Kitchen could have had no patent. And if so again, Levison would include Doughty who precedes Levison; or the use of a *rubber band* to hold the Barlow carbon in Barlow.

The Court in the Westinghouse case further said:

“The claim in question is, to a certain extent, for a function, viz: the admission of air directly from the train pipe to the brake cylinder, and is only limited to such function when performed by the further traverse of the piston of the triple valve. This limitation, however, does not obviate the objection that *the means are not fully and specifically set forth for the performance of the function in question.* * * *

“The difficulty we have found with this claim is this: That, if it be interpreted simply as a claim for the function of admitting air to the brake cylinder directly from the train pipe, it is open to the objection, held in several cases to be fatal, that the mere function of a machine cannot be patented.”

But in that case the Court was able to hold the patent as being saved from the charge of invalidity by determining that the claim was limited to the *special means* shown and described in the patent for performing the function. The Court said:

“There are two other facts which have a strong bearing in the same connection, and preclude the idea that this can be interpreted as a claim for a function, without reading into it the particular device described in the specification.

“One of these is that the claim is for a triple-valve device, etc., for admitting air from the main air pipe to the brake cylinder, ‘*substantially as set forth.*’ *These words have been uniformly held by us to import into the claim the particulars of the specification,* or, as was said in *Seymour v. Osborne*, 78 U. S. 11 Wall. 516, 547 (20: 33, 40) ‘where the claim immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specification it cannot properly be construed in any other way.’ In that case it was held that a claim which might otherwise be bad, as covering a function or result, when containing the words ‘substantially as described,’ should be construed in connection with the specification, and when so construed was held to be valid. To the same effect is *The Corn Planter Patent* (*Brown v. Guild*), 90 U. S., 23 Wall, 181, 218 (23: 161, 168).”

On the question of infringement the words of the Court in the *Westinghouse Case* are directly applicable:

“Under the very terms of the first and fourth claims of the *Westinghouse patent*, the infringing device must not only contain an auxiliary valve, or its mechanical equivalent, but it must contain the ele-

ments of the combination, 'substantially as set forth.' In other words, there must not only be an auxiliary valve, but substantially such a one as is described in the patent i. e. independent of the triple valve.

"Not only has the Boyden patent a poppet instead of a slide valve—a matter of minor importance—but it performs a somewhat different function. In the Westinghouse patent the valve is not in the line of travel between the auxiliary reservoir and the brake cylinder, and admits train pipe air only. In the Boyden patent, it is in the line of travel, both from the auxiliary reservoir and from the train pipe, and admits both currents of air to the brake cylinder. The by-passage, to which the auxiliary reservoir is merely an adit, is wholly wanting in the Boyden device, both currents of air uniting in chamber C and passing to the brake cylinder together, through the poppet valve." We see here that there were two air currents, but controlled in different ways; still both devices were literally readable on the claims sued on. Yet there was no infringement.

THE WORD "BOUND" AS USED IN THE CLAIMS OF LEVISON IS DISTINCTIVELY FUNCTIONAL; AND THE CO-RELATION, AND AT THE SAME TIME THE DISTINCTION BETWEEN THIS EXPRESSION OF "FUNCTION" AND THE IDEA OF "MEANS" FOR ACCOMPLISHING THIS FUNCTION MUST BE CLEARLY BORNE IN MIND, AS LIKEWISE MUST THE PHRASE "SUBSTANTIALLY AS DESCRIBED," WITH WHICH EACH OF THE LEVISON CLAIMS SUED ON CONCLUDES.

It is not trespassing on the time and patience of this Court to say that if this idea of *function* conveyed by the word “bound” should be considered to extend to cover *all* means for accomplishing the desired result that such a claim would necessarily be void as an attempt to patent a principle. If it includes all *binding* means it includes Doughty’s means and a *rubber band*.

In Cimiotti Unhairing Company v. American Fur Refining Co., 198 U. S. 399, 49 L. Ed. 1100; the Court held the patent valid because “Sutton has taken the step which marks the difference between a successfully operating machine and one which stops short of that point and that advance entitles him to the protection of a patent”; yet the Court further held that the defendant’s invention was not infringed, saying:

“And see Kokomo Fence Co. v. Kitselman, 189 U. S. 8, 47 L. Ed. 689, 23 Sup. Ct. Rep. 521, in which case it was held that where the patent does not embody a primary invention, but only an *improvement* on the prior art, and the *defendant’s machines can be differentiated*, the charge of infringement is not sustained.

“In the case under consideration the respondents have dispensed with the *fixed stretcher bar* and have adopted a *movable one*, operated by an entirely different mechanism, capable of *accomplishing a much larger amount of work within a given time*. In the Circuit Court of Appeals it was said to result in a double working capacity and product. It does not seem to us to be a mere transposition or substitution of parts; in the Sutton patent, the *Stretcher bar being*

stationary, there are several mechanisms used for operating the movable brushes and the clipping knives; a different mechanism is used for operating the different parts which are to be brought to the *fixed stretcher bar* in carrying out the operation intended. In the respondents' machine the same application of power *moves the stretcher bar* and, by the co-operation of the feeding apparatus as above outlined, feeds the machine by bringing the pelt forward, at the same time actuating the knives, in practically one operation. This seems to us to be a distinct mechanical departure, as well as an advance upon the Sutton machine, when considered in view of the results accomplished."

Note here: Levison used a carbon bound in by staples so that his carbon is *stationary*. Kitchen uses a carbon bound in by *friction* so that his carbon is *movable*; Kitchen can place his carbon *anywhere* in the book; when he has used a certain number of record leaves he can *change the position* of his carbon in the stubs; when his carbon shows signs of wear and begins to copy dimly, he can *renew* his carbon; if he wants to use his book as a loose leaf carbon book or leave some of the written-on sections of the leaves in the book and detach others, he can entirely *omit* his carbon. He binds his books up without carbons and keeps them in stock and inserts one or more carbons as desired. Levison must bind his carbon up with his book. In appellant's device Kitchen gets a bound carbon or a loose carbon book as required. As said in the Cimiotti case: "This seems to be a distinct mechanical *departure* as well as an *advance* upon the

Levison machine when considered in view of the *result* accomplished.”

II.

THE LEVISON PATENT IS IN NO SENSE A PIONEER AND ITS CLAIMS ARE TO BE NARROWLY CONSTRUED.

In applying the rule “that although the Levison claims are in fact broad enough to include appellant’s structure nevertheless there is no infringement,” it is of course necessary to determine from the record and your Honor’s opinion what degree of liberality of construction is accorded the Levison claims in suit.

The recent case of Autopiano Co. vs. Amphion Piano Player Co., 186 Fed. 159, 163 C. C. A., 2nd Cir., is directly in point:

“The question is whether this constituted a ‘pioneer invention.’ That phrase does not admit of exact definition, but perhaps as good as any is that of Mr. Justice Brown in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 561, 562, 18 Sup. Ct. 707, 718, 42 L. Ed. 1136, where he says that a pioneer patent must be one ‘covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what had gone before.’

“In this case the function had been performed before. It was performed, though not automatically,

by Clarke in the patent which has been mentioned, and it was performed from the outset automatically, though imperfectly and inadequately, by the rollers of automatic musical instruments. * * *

“Nor is it true that O’Connor’s was a wholly novel device, which is the second suggestion of Mr. Justice Brown. Perhaps surface control was a new device at least when used to control lateral deviations, but edge control was not a new device to control such deviations, at least as shown in Cottrell. * * *

“Finally, not only was the device not wholly new, but it was not one of such novelty or importance as to mark a distinct step in the progress of the art as distinguished from a mere improvement or perfection of what had gone before, because the result was precisely an improvement or perfection upon the flange control, as I have said. * * * I do not mean to suggest that to combine together these elements was not a meritorious and excellent invention, for I think it was, nor that it did not require real inventive skill, and was not patentably novel. All that, however, does not make it a ‘pioneer,’ unless it takes its place at the head of the art in means or result, which this patent does not. In one sense, it is, of course, true that any invention must be a distinct step in the progress of the art, but the pioneer step must be in a new direction, not along the path already indicated by what has gone before.”

It seems unnecessary to more than state the rule governing the liberality of construction of pioneer and secondary patents. Judge Ross, of this Honor-

able Court in the case of *Cummings v. Baker*, 144 Fed. 395, says:

“It must be remembered that the patent sued on is in no sense a pioneer one, but a mere improvement on prior portable forges. In such cases the patentee is limited to the precise device, and combinations shown and claimed in his patent.”

Your Honors in *Hardison v. Brinkman*, 156 Fed. 962 where the defendant justified under subsequent patent stated: “The issuance of a patent to a respondent creates a *prima facie* presumption of the patentable difference from the invention of the patent sued on.”

It is not now contended that a subsequent patent is in every case a defense, because such is not the general rule; but it is *evidence*, as your Honors above stated, of a “patentable difference,” and therefore of a *substantial difference*, and not a mere colorable one from the patented invention, but sufficient under certain circumstances to relieve a respondent of the charge of infringement.

Furthermore *infringement* is never *presumed*; and in case of any *doubt* the finding must be against the complainant.

As said by the Supreme Court in *Burr v. Duryea*, 1 Wall. 574:

“Every man has a right to make an improvement in a machine, or evade a previous patent, provided he does not invade the rights of the patentee.”

In determining invention in Levison your Honors find that the Barlow patent “anticipates the appellee’s patent in every feature except one. Instead of having their carbon sheet bound in the book as in the appellee’s patent, it was loose. * * * Eight (18?) years after the issuance of the Barlow patent the appellee conceived the idea of binding carbon sheets with the stubs of the record sheets of the book, so that the carbon sheets would always be in their place.”

(Permit us to call the Court’s attention that with respect to the claims sued on, appellee conceived the idea of binding *a single carbon sheet* (not *sheets*) with the stubs of the record sheets, because these claims are not for the *built-up* sections).

Continuing, your Honors says:

“The patent to James Bengough of January 28, 1896 shows a bound, manifold salesbook” using two bound carbons; and that “the patent to G. E. Doughty of October 11, 1898 is similar to the Bengough device excepting that the carbon sheet instead of being *bound by stitching* in the book, is held therein by a clamp.” (We may again be pardoned for calling attention to the Honorable Court’s error as to the facts of *similarity* between Bengough and Doughty, because the two books are absolutely dissimilar as pointed out at the argument and in appellant’s brief, and as shown by the cuts in appellant’s brief; Doughty having leaves with three separable sections of equal size, similar to Barlow and Levison, only the end sections are turned over to shorten the length of the book, and the two-piece carbon which is the length

of two of the sections, and is held or bound as Levison said, in the book. It was pointed out in the argument how the appellee had introduced a “bogus” copy of Doughty bound in the middle and had apparently succeeded in misleading Judge Van Fleet).

Your Honors further say:

“In addition to the presumption which arises from the issuance of the patent to the appellee, there are to be taken into consideration as sustaining his patent, the further facts that when his invention was made, there was a want in the art for such a device, that in the prior art there were well recognized and admitted defects, and that the appellee’s device eliminated those defects and went into general and successful use. In view of all these considerations, we find the evidence insufficient to overturn the finding of the Court below that the appellee did exercise inventive faculty in devising the book for which he obtained his patent.”

A careful reading of the Opinion shows that your Honors do not invest the Levison patent with the attributes of a pioneer, but as being simply an “improvement” on what had gone before.

McCormick vs. Talcott, 20 How. 402.

Of course it is elementary that “extent of use” or “general or successful use” (to use the words of your Honors) of a patented article is no measure of the *quantum* of invention, and evidence to that effect is receivable only where the question of novelty is in

grave doubt. As said by the Supreme Court in *McLain v. Ortmeier*, 141 U. S. 420, 35 L. Ed. 800, it was held that while “in a *doubtful case* the fact that the patented article had gone into general use is evidence of its *utility* it is not conclusive even of that, much less of its patentable novelty.”

There are scores of cases which go to show that “popularity,” “large sales,” “extent of use,” are evidence *only in very doubtful cases*.

Voightmann vs. Weis, 148 Fed. 848;

Adams vs. Ballaire, 141 U. S. 529; 35 L. Ed. 849;

Grant vs. Walter, 148 U. S. 547; 37 L. Ed. 552;

Duer vs. Corbin, 149 U. S. 216;

Union vs. Peters, 125 Fed. 601;

Mast vs. Stover, 177 U. S., 493;

Rose vs. Dowden, 157 Fed. 681;

Lehigh vs. Kearney, 158 U. S. 461; 39 L. Ed. 1055;

Olin vs. Timken, 155 U. S. 141; 39 L. Ed. 100;

Hotel Security Checking Co. vs. Lorraine Co., 155 Fed. 298;

Tubelt Co. vs. Friedman, 158 F. R. 430, 439;

Richards vs. Elevator, 159 U. S. 477, 40 L. Ed. 225;

American vs. Bullivant, 117 Fed. 225; 54 C. C. A. 287;

McClain vs. Ortmeyer, 141 U. S. 419, 35 L. Ed. 800;

Falk vs. Missouri, 103 Fed. 295; 43 C. C. A. 240;

New vs. Bevin, 73 Fed. 469; 19 C. C. A. 534;

Dodge vs. N. Y., 150 Fed. 738; 80 C. C. A. 404.

These cases might be multiplied indefinitely.

Again your Honors state "the presumption which arises from the issuance of the patent"? but that is measure of the *quantum* of invention: in fact the value of such a presumption is growing less each year with the vast increase in the number of patents and the inadequate facilities of the Patent Office for handling and properly examining all the applications that come before the Examiners. Thus to illustrate: the Commissioner of Patents himself conceded, before the Committee on Patents of the House of Representatives in the hearings given to House Bills 12,368, 18,884 and 18,885, to revise and amend the statutes relating to patents, on the 23rd and 24th days of February, 1910, that a majority of the patents issued were not worth the paper on which they were written. The statement of the Commissioner will be found at

pages 44 and 45 of the Official publication. On page 44, the Honorable Commissioner said: "I have said time and time again that these patents issued—the majority of them, I mean—by the United States Government are not worth the paper they are written on, and the inventors are driven into all sorts of litigation." Again, on page 45, in speaking of the conditions that now exist in the Patent Office, the Honorable Commissioner said: "We are handing out to-day 60 per cent, of the cases, patents that are almost worthless, in whole or in part."

To show that this complaint is not of recent date, is seen by reference to the Opinion of Judge Butler in *Haughey v. Lee*, 48 Fed. 384, (when all patents went on appeal direct to the Supreme Court); Judge Butler pointing out that Vol. 132 of the United States Supreme Court Reports contained no less than *eight* cases of patents overturned for want of invention. An examination of the Federal Reporters will prove equally instructive as to this matter. Counsel for appellant knows from his personal experience as a Patent Solicitor, and in his experience in prosecuting thousands of applications before the Patent Office, that the methods in the Patent Office were extremely lax at the time Levsion's application for patent was pending.

As to the degree of liberality to be accorded Levison's claims you are to take into account the *claim of the Barlow patent*, and apply the same rule which you applied in the case of *Best v. Holt Mfg. Co.*, 172 Fed. 409, in construing the Best patent there sued on

in the light of the *claim of the prior Berry patent*. In that case Best infringed claim 11 of Berry, and your Honors held that the Best patent, although for a very meritorious invention and one which had gone into successful and extensive use, was nevertheless only an *improvement* patent. So here *Levison infringes the Barlow claims* and why should not the same rule apply.

From a careful perusal of your Honor's opinion in the case at bar there seems to be nothing to indicate that Levison is held to be a *pioneer*, or that he made anything more than a step forward in the art. In fact appellee has never claimed more for the patent than that; but has relied to sustain infringement, upon the *literal* application of the word "bound," as found in Levison's claims to the appellant's device.

LEVISON'S INTENTION AS SHOWN BY HIS TESTIMONY AND HIS PATENT.

The *drawings* of the Levison patent show the carbon bound permanently into a stub by wire stitching or staples.

LEVISON THE PATENTEE TESTIFIES, REC. 49 THAT HE HAS NEVER BOUND HIS CARBON INTO HIS BOOK IN ANY OTHER WAY THAN BY STITCHING "AS DESCRIBED IN THE CLAIM IN HIS PATENT"!

Thus he says:

“X. Q. 20. That plurality of sections is what you are using, and you are *stitching* your carbons into books of that sort, and, always have?

“A. I am *stitching* my carbons into books *as described in this claim in this patent.*”

“X. Q. 24. You do that when you make up your book?

“MR. WHITE: We object to that as immaterial.

“A. Yes, we bind it into the stub when we made up the book.

“X. Q. 25. (By MR. TOWNSEND): Your carbon cannot be removed without tearing it out, either can it?

“MR. WHITE: We object to that as immaterial.

“A. In the particular book that we are manufacturing, extensively, they cannot be taken out, and *that is the selling of it. That is the reason that they sell, because the carbons cannot be taken out.*”

Thus, we see the full meaning of the words, “substantially as described” as used in Levison’s patent.

We may be pardoned for referring to the significant inquiry of his Honor, Judge Wolverton, (or possibly it was Judge Morrow), at the hearing and addressed to Mr. White, Counsel for appellee, if he, Mr. White, contended that the term “bound” in the Levison claims covered the use of a *rubber band* around the Barlow book to hold the loose Barlow carbon in place; and Mr. White stated that the claims were broad enough to include such binding means.

Your Honors may take judicial notice of the effect of a “rubber band” so applied in determining the present question which is as follows: The *quantum* of invention in Levison for the purpose of determining infringement.

As a “rubber band” would only hold the carbon in place by *friction* surely your Honors will not say that Kitchen’s *patented* removable *frictionally*-held carbon although a “bound” carbon, is bound in the sense as to make appellant an infringer?

In *Eames v. Godfrey*, 1 Wall. 78-79, 17 L. Ed. 547, the Supreme Court said in speaking of a combination patent:

“The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others, is therefore not the thing patented. *It is not the same combination if it substantially differs from it in any of its parts.*”

Consequently the term “bound” in the Levison claims must of very necessity be read “substantially as described” in the Levison specifications or *shown in his drawings*, since drawings and specifications are to be read each by the other.

“When the nature of the case admits of drawings, the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two

witnesses, which shall be filed in the Patent Office, and a *copy of the drawing*, to be furnished by the Patent Office, *shall be attached to the patent as a part of the specification.*” Sec. 4889 U. S. Revised Statutes.

“While the invention of a patent must be measured by the claims, yet they cannot be considered to the exclusion of the specifications, but *claims, specifications, and drawings showing the particular apparatus must be considered together*, and must point out the principle by which the invention is practically operated, and, to make out a case of infringement, the apparatus of the defendant must embody such principle of operation.”

Herzog vs. N. Y. Tel. Co., 172 Fed. 425, (1st syllabus) ; affirmed 176 Fed. 349.

The true rule is laid down in *Amer. Bank Protection Co. vs. City Nat. Bank*, 181 Fed. 373, 378:

“It is furthermore settled that a patent is to be liberally construed, so far as is consistent with the language used, so as to sustain the just claims of the inventors (*Rubber Co. v. Goodyear Co.*, 9 Wall. 788, 19 L. Ed. 566; *Klein v. Russell*, 19 Wall. 433, 22 L. Ed. 116), and that for such purpose each claim of the patent is not to be construed as though it was complete in itself, separate and apart from the specifications, but that the claims of the patent are to be read in the light of the specifications *and drawings* which accompany them, for the purpose of arriving at their just construction, although not to vary or change them, *especially where the claims themselves contain the*

words, ‘*substantially as described,*’ or ‘*substantially as set forth,*’ or equivalent phrases, which import into the claims the particulars of the specifications and carry into the claims the description of the specifications. Seymour v. Osborne, 11 Wall, 516, 20 L. Ed. 33; Corn Planter Patent, 23 Wall. 181, 218, 23 L. Ed. 161; Westinghouse v. Brake Co., 170 U. S. 537, 558, 18 Sup. Ct. 707, 42 L. Ed. 1136; Stilwell-Bierce Co. v. Cotton Oil Co., 117 Fed. 410, 54 C. C. A. 584 (C. C. A., Sixth Circuit); Sanders v. Hancock, 128 Fed. 424, 63 C. C. A. 166 (C. C. A., Sixth Circuit); Maunula v. Sunell (C. C.) 155 Fed. 535, 542; Anderson v. Collins, 122 Fed. 451, 458, 58 C. C. A. 669 (C. C. A., Eighth Circuit); Mossberg v. Nutter, 135 Fed. 95, 99, 68 C. C. A. 257.”

Of course it is not maintained that the words “substantially as described” as used in a claim will always limit a patentee; due regard being given to the place of the patent in the art, whether it is the first or last, or intermediate of a large line of endeavors in the same field.

But here we have an express statement of intention of the patentee himself on the witness stand; we have the holding of the Court in the Westinghouse case; and we have the state of the art as applied to Levison.

As was said in Autopiano Co. vs. Piano Player Co., 186 Fed. 159, 165 C. C. A., 2nd Circuit, where, just as here the appellant justified under a subsequent patent: (and the *Levison patent* was cited against the Kitchen patent as a reference while Kitchen’s was

pending in the Patent Office ; although this latter does not appear in the Record, yet it is the fact) :

“Moreover, there is a strong presumption that there is patentable novelty between the two, one not being an improvement upon the other (Kokomo Co. v. Kitselman, 189 U. S. 8, 23, 23 Sup. Ct. 521, 47 L. Ed. 689), *and this is especially the case when the earlier patent is repeatedly cited against the subsequent patent*, as was the case (New Jersey Wire Co. v. Buffalo Metal Co., 135 Fed. 1021, 68 C. C. A. 672, and (C. C.) 131 Fed. 265, 268).”

As was also said in the same case :

“No fair intendment of any of the claims in question can be held to include Exhibit 4, unless I should treat them like the ‘nose of wax, which may be turned and twisted in any direction,’ and into which Mr. Justice Bradley says that courts must not permit claims to be transfigured. *White v. Dunbar*, 119 U. S. 47, 51, 7 Sup. Ct. 72, 30 L. Ed. 303. *It is no hardship to O’Connor to be limited to the invention which he so specifically defined and which he obviously alone intended.*”

So here unless your Honors expand the “binding” means of Levison so broad as to “cover all binding means” as you state in your opinion and so include *Doughty* (and please note *Doughty* has precisely the same *three-equal-division* sheet arrangement as Levison and Barlow and *double-face bound* carbon two-thirds the length of the sheet)—the *patented friction binding means of Kitchen* cannot under the law as

above pointed out be an infringement. Neither, in your Honors sustaining the Levison patent, is it any hardship on Levison "to be limited to the invention which he so specifically defines and which he obviously alone intended."

As pointed out to your Honors who heard the argument, the loose *leaf carbon of Barlow* can easily be slipped into the stub and will be held tight enough by friction so that it will not fall out. Your Honors are invited to try the experiment with the Barlow book, Complainant's Exhibits 9 and 13. In fact it would be most extraordinary if hundreds of users of Barlow books long before Levison's advent into the field had not done that very thing of sticking the end of the carbon into the stub to hold it, when they found the carbon had a tendency to blow away. Consequently it seems absolutely essential both from the point of view of the facts and the law and the justice of the matter to say that Levison is limited to his precise binding means "show and described," and that they do not cover *friction* binding as practised and *patented* by appellant.

THE SELDEN AUTOMOBILE CASE AND ITS APPLICATION TO THE QUESTION OF CONSTRUCTION.

One of the most recent and remarkable examples of strict construction of patent claims, even in a *pioneer patent*, by a Court noted for its liberality in upholding and in construing patents, is seen in the Opinion of the Circuit Court of Appeals for the Second

Circuit in *Columbia Motor Car Co. vs. Duerr Co.*, 184 Fed. 893; the suit being on the Selden automobile patent, which was applied for in 1879 and issued in 1895.

We trust that a somewhat extended reference to this case may not be considered out of place, nor trespassing upon your Honors' patience and time, because it bears directly on the point in issue and is the mature and well considered opinion of a Court of co-ordinate jurisdiction.

The Court in referring to the importance of the Selden invention said:

“This patent, even if it be useful only for tribute, must be viewed without prejudice and with absolute judicial impartiality.

“But, while we should be careful to avoid viewing the patent with disfavor, we should be equally careful to avoid considering it with too much favor on account of its subject-matter. Fifteen years ago hardly any one had seen an automobile. Ten years ago they were rare. Today they are in use by tens of thousands, and tens of millions of dollars are invested in them and in their manufacture. The development of the automobile has been nothing short of phenomenal, and every one is inevitably impressed with its importance. *Consequently, when we see that 30 years ago an application for a patent was filed which even pointed the way to the modern automobile, we can hardly fail to receive the impression that an idea of great importance must have been embodied in it.*”

The broad claim of the Selden patent included as an element, “a liquid hydro-carbon gas engine of the *compression* type”; but despite the novelty of the idea of the combination, and the broad language used both in the Selden claim and in the Selden specifications, the Court proceeded to limit the claim to *one of two* “liquid hydrocarbon gas engines of the *compression* type” *known at the time of Selden’s application*.

The Court said (page 898) :

“Liquid hydro-carbon engines were in use, both of the compression and non-compression types. The phrase in the claim, ‘a liquid hydro-carbon engine of the compression type,’ *is descriptive of the Brayton engine, which came into use about 1873, and of the Otto compression engine, which came into use a little later but still was in the antecedent art.* The Brayton was undoubtedly the leading compression engine at the time of this application, but it was later superseded by the Otto.

“These two engines—the Brayton and the Otto—play important parts in this case. We shall later have occasion to examine them at length and to compare them as belonging to two well-defined types of *compression gas engines*—the ‘constant pressure’ type and the ‘constant volume’ type. But it is unnecessary to describe them at this time nor to define the terms which we have just employed. It is sufficient now to state the fact that the engine element of the claim—considered as an engine and not neces-

sarily as a part of a combination—was in existence at the date of the alleged invention.”

(The foregoing is apt with respect to Levison where your Honors have found that there are *two kinds* of “binding” means; the “permanent” or non-removable binding means and the “temporary” or *removable* binding means. Both these binding means were in the “antecedent art.”)

The Court found that Selden had reorganized the “Brayton” engine and at page 908 said:

“We have nearly broken established rules by looking at the drawings by themselves to ascertain the changes made in that engine. There is little enough to be found about the improvements to it and nothing at all about the alterations of other engines. The patent does not pretend or attempt to lay down any rule for reorganizing compression engines to fit them for vehicular purposes.”

(Levison shows in his *drawings* the “permanent” binding means and his testimony quoted above, expressly states that that is of the essence of his invention.)

In determining the breadth of construction to be accorded the Selden patent, the Court said at page 901-902:

“Taking the patent according to its terms, the case apparently presented is the ordinary one in which a patentee claims a broad invention and describes what he considers to be the best mode of applying it, but is

not confined to that method. And if the prior art permitted such a patent in this case it might well be that it would be valid. But the prior art did not permit such a patent. Every element in the claim was old, and the combination itself was not new. Combinations of non-compression gas engines with the other elements had been in use, and Brayton had employed a 'liquid hydro-carbon engine of the compression type' in a vehicle.

“Even if the Brayton uses were not precisely anticipatory, we can reach no other conclusion than that with them in the prior art the claim in question must be held invalid for want of invention if it be given the broad construction the language apparently calls for. Moreover, if we give it a slightly narrower construction and treat it as covering the selection of the Brayton type of compression engine, the same conclusion must be reached. Invention would not be involved in the mere choice of that type of engine, for Brayton had previously made the same selection for his street car and boats. And, even if the Brayton engine had been used only for stationary purposes, it is by no means certain that its mere selection for incorporation in a motor vehicle without adaptation would have involved invention.

“In *re Faure's Appeal*, 52 Off. Gaz. 754 (Supreme Court, District of Columbia), is in point. In that case Faure claimed a patent for the combination of an electric motor with a vehicle. It appeared in that case, as in this, that boats had been propelled by the same kind of motor. The Court said (page 756):

“ ‘It is made evident that the mechanical arrangements for applying the power are not new, being familiar to all experts; and that the result is not new, viz., the movement of vehicles by electrical storage batteries. It is admitted that Trouve had propelled boats in this way. The contention that such a use did not anticipate this application because that experiment was on water and this invention is designed for use on land seems untenable. The propulsion of vessels through water by such batteries is within the same principle as locomotion on land.’

“ ‘In *Shaw Electric Co. v. Worthington* (C. C.) 77 Fed. 992, 993, the patent was for an improvement in traveling cranes through the substitution of independent electric motors for the power previously furnished by steam power. Judge Acheson said:

“ ‘The facts, then, being as above stated, what element of invention is to be found in the patent here in suit? In view of the previous employment of electric motors in propelling street cars, driving machinery in mills, working elevators, etc., the mere application of electric motors to traveling cranes certainly did not involve invention, even had Shaw been the first to operate cranes electrically. The inventive faculty was no more exercised here than in a multitude of other instances in every branch of industry where the electric motor has been substituted for the steam engine or other source of power.’

— — — — —

“ ‘But we are reluctant to so construe the claim that it must be held invalid for want of invention. *We*

are of the opinion that the patentee had ideas ahead of the times and appreciated many aspects of the problem to be solved in creating a practical motor vehicle. Reading his statement of the difficulties encountered, his manner of meeting them, and the advantages of his discovery, we think it evident that he understood that an engine suitable for a light vehicle could not be taken bodily from the prior art and used without change, but that modification and adaptation were required. In our opinion *the statement in the patent that any form of compression engine may be employed is inconsistent with the intention disclosed by the patentee in the patent as a whole* and should not have too much stress laid upon it. We also think that we should examine the specification, including the *drawings and the model*, to determine whether the patentee in addition to expressing the need of adapting an engine to the purposes of a motor vehicle shows that he actually adapted one. It may well be that the claim is limited by the specification should be held to be valid.”

(This is applicable to the question of *construction* of the three Levison claims sued on in view of the prior art.)

Coming to the conclusion of infringement and construction the Court said in the Selden case:

“We thus find that the defendants use an improved Otto engine which retains the principle of that type and is, in its essentials, a four-cycle constant volume (or explosion) *compression* gas engine. Obviously it is not *identical* with Selden’s improved

Brayton engine, which is a two-cycle constant pressure, or slow combustion) *compressed* gas engine; and so the final question is whether they are, under the patent, equivalents.”

In the conclusion the Court said in finding for the defendants:

“The Brayton engine was the leading engine at the time, and his attention was naturally drawn to its supposed advantages. He chose that type. In the light of events we can see that had he appreciated the superiority of the Otto engine and adapted that type for his combination his patent would cover the modern automobile. He did not do so. He made the wrong choice, and we cannot, by placing any forced construction upon the patent or by straining the doctrine of equivalents, make another choice for him at the expense of these defendants who neither legally nor morally owe him anything.”

It is the earnest contention of your petitioner that the Levison claims sued on should be construed to cover the particular binding means elected by him, and not the particular *patented friction binding means* of the appellant; because to do otherwise is to “make another choice” for Levison “at the expense of this defendant who neither legally nor morally owes him anything.”

In *Cushman Paper Box Co. v. Goddard*, 95 Fed. 644, 669, C. C. A., Judge Putnam said in holding the patent valid, but not infringed and where the facts were not dissimilar to those in the present case:

“It is apparent from the proofs that *the respondents honestly regarded their method of construction in these particulars as preferable to that of the complainant*. Whether or not they were correct in this, it would seem, to use the language of the opinion in *Westinghouse v. Brake Co.*, 170 U. S. 537, 573, 18 Sup. Ct. 707, that *the complainant’s method* for overcoming the difficulties in delivering the box-ends to the box-body after they are in position one over the other *would not naturally have suggested the device adopted by the respondents*. We conclude that, on the proofs in this record, we cannot find that the respondents have infringed.”

Under the above doctrine, and of *Electric Signal Case* and others, is not the question of equivalency in this case dependent on whether the means used by the respondent for “binding” his carbon in the book would “naturally have suggested itself” to any skilled mechanic in lieu of the staple or stitched binding of *Levison*? The answer must be in the affirmative in order to hold appellant an infringer; and that it cannot be answered in the affirmative is conclusively shown by the fact that the special *friction binding means* of the appellant has been held to be patentable to Mr. Kitchen, by the same tribunal that granted *Levison* a patent, and long subsequent to *Levison*; and being *patentable* it *per se* is not a mechanical equivalent of *stitching* or “permanent” binding.

SUMMARY.

Applying the principles of the foregoing cases to the question of infringement in the case at bar, we have:

First;—That although the Kitchen device corresponds with the letter of the Levison claims that does not settle conclusively the question of infringement. (Westinghouse Case). In determining this question it is proper to consider: first, the patentable distinction between the two; and second, the different modes of operation; three, the practical advantages of one over the other. The Kitchen device responds to all these tests as disproving infringement in view of the limited scope of the Levison patent *with respect to the particular claims sued on*.

Second;—The word “bound” in the claims is functional. Being functional the “binding means” of the patent must be “substantially as shown and described” in the patent. The only thing “shown and described” in Levison are *wire staples* passing through the stubs and leaves of carbons; otherwise, the patent is void. (Westinghouse v. Boyden.)

Third;—The *frictional* binding means of appellant is, by the authority of the Patent Office in granting the Kitchen patent over both the Barlow patent and the Levison patent, not included among the “known” equivalents of Levison’s binding means; Electric Signal Co. vs. Hall Signal Co., 114 U. S. 87, 96; and the fact that this *frictional* binding means of appellant has been held patentable over the binding means of

Levison, *differentiates* the appellant's device from that of the appellee, so that the charge of infringement is not sustained. *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399; *Kokomo Fence Co. v. Kitselman*, 189 U. S. 8, 47, L. Ed. 689. Such differences could not be *patentable* if they were merely "colorable."

Fourth;—For inasmuch as we understand your Honors to hold the Levison patent "lies in a narrow compass," (as indeed it must in view of the prior art), then it is most respectfully submitted that defendant's *patented frictional* binding means cannot be held to be the equivalent of the binding means "substantially as described" in Levison.

Fifth;—This Court is as much bound to protect the appellant from the charge of infringement and to allow the public to profit by his competition if the law does not make him an infringer, though his patented device be literally within the terms of Levison's claim, as it is bound on the other hand, to see that Levison's patent is entitled to be *liberally* construed. Any doubt on the question of *infringement* must be determined in favor of the defendant-appellant just as any doubt affecting the *validity* of the patent sued on must be decided in favor of the complainant appellee.

Sixth;—The claims do not of themselves, nor does the patent, indicate that the patentee intended to embody within his invention any such ingenious *friction* binding means as employed by appellant. Levison too, distinctly testified he *intended* the stitching bind-

ing shown in his drawings. Rec. 49-50 quoted *supra*. For the Court to expand appellee's claim is not only in contravention of the doctrine laid down in numerous cases, but it operates to work an unnecessary hardship on appellant and on the public; it being shown that the City and County of San Francisco if forced to buy the Levison book must pay from 50% to 60% more than ordinary customers pay Levison for the same book. (Rec. 156-7). The equities are strongly with the appellant and the public.

CONCLUSION.

The question presented by this petition was not treated or raised in any way before the lower Court, nor in the brief of appellant nor on the argument; the point naturally not being raised by the complainant and the respondent having been of the opinion that the Kitchen device was *not* within the claims sued on.

There are no large interests here at stake; the defendant has ceased all infringement pending the outcome of this litigation; yet these facts do not militate against the importance of the principle involved. The reason for praying the granting of this motion lies more in the fact of the importance of this Honorable Court's decisions in patent matters especially, as determining the law of patents for this Circuit; and the further fact that those of us who are engaged almost exclusively in patent practise, are particularly desirous that this Court may not be committed to any

erroneous or incomplete view as to the established law governing the construction of patents.

It is the desire of all inventors and all honest business enterprises to see patents liberally and fairly construed; and this Court's favorable attitude towards patents, as evidenced in various instances in sustaining patents of great practical value, is and should be a matter of profound satisfaction both to patent attorneys and the commercial world.

Counsel knows of no case in which your Honors have ever passed upon the question herein presented, and therefore it is most earnestly urged that the conclusion reached as to infringement may be reconsidered. A decree of non-infringement would in no way operate as a reversal or modification of this Court's attitude as to liberality of construction, because after all each patent case must be decided on the particularly circumstances surrounding it; and the circumstances and the law in our humble opinion justify if not demand that the appellant's device be considered *outside* the *spirit* of the claims sued on, even though it is within their *letter*.

It is therefore respectfully asked that the decree may be modified to the extent of holding non-infringement by appellant.

Respectfully submitted,

CHAS. E. TOWNSEND,

Counsel for Petitioner.

CERTIFICATE OF COUNSEL.

I, the undersigned, Counsel for Petitioner, hereby certify that the foregoing petition is not interposed for delay and in my judgment is well founded.

CHAS. E. TOWNSEND,

Counsel for Petitioner.